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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,832	03/30/2001	J. T. Lin		3717

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EXAMINER	
FARAH, AHMED M	
ART UNIT	**PAPER NUMBER**
3739	14

DATE MAILED: 10/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/820,832	T. J. Lin
Examiner	**Art Unit**
Ahmed M. Farah	3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *three* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Jul 21, 2003* .

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1 and 3-20* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1 and 3-20* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, *3-5,* and 12-14, and 18-20 are again rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S.

Patent No. 6,258,082 B 1. Although the conflicting claims are not identical, they are not patentably distinct from each other because they teach analogous ophthalmic laser surgery methods for treating presbyopic patient comprising the steps of providing ablative laser beams in the UV and in the JR wavelengths; and directing the ablative laser to the presbyopic eye to treat presbyopia.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 3, 4, 11-13, and 17-20 are again rejected under 35 U.S.C. 102(b) as being anticipated by Schachar U.S. Patent No. 5,503,165.

Schachar discloses an ophthalmic surgery method for treating presbyopic patient by increasing the effective working distance of the ciliary muscle and the zonular fibers connected to the corneal lens of the eye. Here, 'the increase of the effective working distance of the ciliary

muscle and zonular fibers' is treated to be analogous to the increase "via the movement of the ciliary body and zonal fiber," *as claimed* Schachar teaches that the increase of the ciliary muscle movement is accomplished by manipulation of the zonulas with an external means such as surgical procedures, treatment with enzymes, heat or optical irradiation.

As to the limitation *"movement of the ciliary body is provided by the increase of the flexibility of said laser beam ablated sclera tissue which is filled in by sub-conjunctival tissue"* in claim 1, ablating sclera tissue would inherently/automatically result in the area being filled in by portion of the conjunctiva that is proximal to the sclera, i.e., the sub-conjunctival tissue, as presently claimed.

In reference to claims 11-13, Schachar describes various laser sources that are suitable for the treatment including UV and IR lasers (see claims 12-31).

10/6/03

5. Claims 1, 3, 4, 11-13, and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Schachar U.S. Patent 5,489,299.

Schachar discloses the removal of sclera tissue in a predetermined pattern by ablating corneal tissue using one of a variety of lasers, including YAG laser (Col. 8, lines 10-18). As to the limitation that *'subconjunctival tissue replaces the removed sclera tissue, increasing the flexibility and movement of the ciliary body'* recited in claim 1, the portion of the conjunctival tissue that is proximal to the removed sclera (sub-conjunctival tissue) inherently fills the void.

6. Claims 1, 3-5, 12-14, and 18-20 are again rejected under 35 U.S.C. 102(e) as being anticipated by Lin (U.S. Pat. No. 6,258,082 B1).

Lin discloses ophthalmic surgery system and methods for treating presbyopic patient comprising the steps of providing ablative laser (UV and IR lasers); and directing the ablative laser to the presbyopic eye to treat presbyopia.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims *5,* 7-10, 14-20 are again rejected under 35 U.S.C. 103(a) as being unpatentable over Schachar in view of Odrich et al. (U.S. Pat. No. 6,280,435).

Schachar, described above, does not teach a method of scanning the treatment laser beams in a predetermined patterns around the area of the cornea.

However, Odrich et al. disclose an alternative method and systems for laser treatment of presbyopic comprising the step of scanning ablative laser in a preselected pattern to ablate predetermined portions of the corneal. They teach that the scanning is performed by using optical scanning elements such as rotating mirror and prisms (Col. 17, lines 60-64). They further teach the use of rotatable masks, variable width slits, and variable diameter iris diaphragms to generate

the predetermined patterns. In reference to claim 9, Odrich et al. disclose translation device used for the scanning (see Col. 11, lines 8-16).

Therefore, it would have been obvious to one skilled in the art at the time of the applicant's invention to modify Schachar in view of Odrich et al. to scanning ablative laser in a preselected pattern in order to ablate predetermined portions of the corneal, and to use variable aperture devices in order to shape the ablative light to produce the predetermined patterns.

Response to Arguments

9. Applicant's arguments filed on July 21, 2003 have been fully considered but they are not persuasive. The applicant argues that the Schachar references (U.S. Patent No. 5,503,165 and 5,489,299) do not teach or suggest that the ablated sclera tissue will be filled in with subconjunctival tissue as recited in the claims. He further states that according to his invention, 'movement of the ciliary body is provided by the increase of the flexibility of the laser beam ablated sclera tissue which is filled in by sub-conjunctival tissue.'

In response to this argument, Schachar references teach that presbyopia may be corrected by laser ablation of the sclera to weaken the sclera and cause expansion of the sclera as a result of intraocular pressure, restoring the range of accommodation. Schachar further teaches that the sclera should be weakened by ablation in the region of the ciliary body :

> If the sclera is weakened in the area adjacent to the ciliary body, the IOP will cause that portion of the sclera to bulge outward, ... The sclera may be thinned or weakened by the surgical removal of a portion of its collagenous

> substance, as, for example by ablating a portion of the thickness of the sclera. This thinning can be accomplished by paring or by abrading the surface or by ablating the surface with laser irradiation.

Schachar '299, column 7, lines 32-34 and lines 53-59. Hence, the examiner's position is that ablating sclera tissue would result in the area being filled in by portion of the conjunctiva that is proximal to the sclera, i.e., the sub-conjunctival tissue. Therefore, Schachar inherently provides the recited function.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. Farah whose telephone number is (703) 305-5787. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak, can be

reached on (703) 308-0994. The official fax number for the group is (703) 872-9302; the fax number for After Final is (703) 872-9303; and the Examiner's Desk-top fax is (703) 746-3368.

A. M. Farah

Patent Examiner (Art Unit 3739)

October 2, 2003

Roy Gibson

Primary Patent Examiner